

REMARKS

Claims 11-13 are pending in this application. By this Amendment, claims 1-10 are canceled without prejudice to, or disclaimer of, the subject matter recited therein. The specification is amended and claims 11-13 are added.

I. Information Disclosure Statement

The Office Action indicates that the Information Disclosure Statement filed on November 24, 2004 failed to comply with 37 C.F.R. §1.98(a)(2)(iii) which requires a copy of a pending U.S. application that is being cited in the Information Disclosure Statement.

A copy of U.S. Patent Application 10/701,487 was provided with the Information Disclosure Statement filed on November 24, 2003 as evidenced by the attached date-stamped filing receipt indicating that three references were filed with the Information Disclosure Statement as listed on PTO Form 1449. Accordingly, the Information Disclosure Statement filed on November 24, 2003 complied with requirements of 37 C.F.R. §1.98(a)(2)(iii) in effect at that time.

II. The Specification

Although not objected to, the specification is amended to correct a minor typographical error.

III. Claim Objections under 35 U.S.C. §102

Claims 1, 2, 8 and 10 are rejected under 35 U.S.C. §102(b) as anticipated by JP 10-018950 to Araki et al., ("Araki"); claims 1, 2 and 5-10 are rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent Publication 2004/019727 A1 to Kurasawa et al., ("Kurasawa"). As claims 1-10 are rejected the rejection is moot.

IV. Claim Objections under 35 U.S.C. §103

Claim 3 is rejected under 35 U.S.C. §103(a) as unpatentable over Araki and claim 4 is rejected under 35 U.S.C. §103(a) as unpatentable over Araki in view of U.S. Patent No. 5,233,877 to Campbell. As claims 3 and 4 are canceled the rejection of those claims is moot.

V. New Claims

Claims 11-13 are allowable over the applied references of record as none of the references, whether considered alone or in combination, disclose or suggest a starter for cranking an internal combustion engine having a ring gear, the starter comprising, *inter alia*...a crank bar driven by the plunger for bringing the pinion-rotation-restricting member into engagement with the pinion gear...the crank bar is composed of a first portion and a second portion, formed separately from each other, the first portion consisting of a rod portion extending in the axial direction of the starter and an operating portion being bent from the rod portion and contacting the pinion-rotation-restricting member, the second portion consisting of a coupling portion coupled to the plunger of the magnetic switch; and the first portion and the second portion are made of respectively different materials.

Furthermore, the combination of references fails to disclose the starter as recited in the claims, wherein the coupling portion is hardened by heat treatment to provide abrasion durability, or the first portion and the second portion have respectively different cross-sections.

Araki discloses a starter having an interlocking rod 6 made of a bent round bar of non-magnetic stainless steel (see [0038] and Figs. 1 and 5a-5d). The interlocking rod 6 consists of three portions including an operation section 62 which contacts the pinion 1, the intermediate portion 63, and the operated section 64 which engages with the plunger rod 42 of a magnet switch 4 (see paragraph [0038]). As shown in Figs. 2 and 5 of Araki, the round non-metallic stainless steel 6 includes two narrow diameter portions 60 formed in the intermediate portions

63. The rod 6 is supported to revolve freely by bearings 65 which fit into each narrow diameter portion 60 formed in the intermediate portion 63 of the rod 6 (see paragraph [0040]). Thus, Araki fails to disclose a crank bar composed of a first portion and a second portion, formed separately from each other, the first portion consisting of a rod portion extended in the axial direction of the starter and an operating portion being bent from the rod portion and contacting the pinion-rotation-restricting member, the second portion consisting of a coupling portion coupled to the plunger of the magnetic switch, and the first portion and the second portion are made of respectively different materials, as recited in claim 11 or wherein the first portion and the second portion have respectively different cross-section, as recited in claim 13.

Applicants respectfully submit that U.S. Patent Application Publication No. 2004/0108727 to Kurasawa et al. (Kurasawa) is not available as prior art because Applicants claimed priority from JP 2002-355896, which was filed on December 6, 2002, which date is prior to the November 6, 2003 U.S. filing date of Kurasawa. A claim for priority under JP 2002-355896 was filed on November 24, 2003 and a certified copy of the priority document was submitted concurrently with the claim for priority in compliance with 35 U.S.C. §119. A verified English-language translation of the priority document is submitted concurrently herewith which includes the statement that the translation is accurate in compliance with MPEP §201.13.

As Kurasawa is not available to form the basis of the rejection of this application, Kurasawa may not be applied against the pending claims.

Campbell merely relates to a starter motor drive gear and fails to disclose a crank bar at all.

In rejecting the canceled claims, the Office Action alleges that having crank bar parts made of different materials would have been obvious since it has been held that selecting a

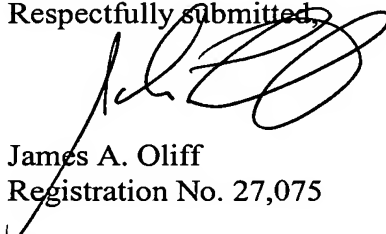
known material for an intended purpose is obvious. However, as none of the available applied references disclose a crank bar composed of a first portion and a second portion, formed separately from each other, it would not have been obvious to make the first and second portions of the respectively different materials.

VI. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 11-13 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


James A. Oliff
Registration No. 27,075

John W. Fitzpatrick
Registration No. 41,018

JAO:JWF/lbg

Attachments:

English-language Translation of Priority Document
Petition for Extension of Time

Date: February 1, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--

PTO RECEIPT FOR FILING OF PAPERS

The following papers have been filed:



Appln t, ck # 148589 (\$770), 20 pp spec/10 clms/abstr., 6 pp. dwngs (Figs 1-6), DEC,
Assign t, ck # 148590 (\$40), ASSIGN, IDS, pto 1449 w/3 refs., 2 trans., + 2 abstr., Cert cpy
JP 2002-355896 (12/06/02)

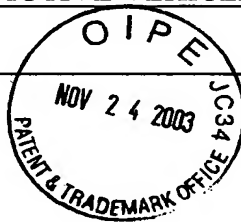
Name of Applicant: Mitsuhiro MURATA, Masami NIIMI, Tsutomu SHIGA and Masanori OHMI

Serial No.: New U.S. Patent Application

Atty. File No.: 117857

Title (New Cases): STARTER HAVING PINION-ROTATION-RESTRICTING MEMBER
FOR USE IN AUTOMOTIVE VEHICLE

Sender's Initials: JAO/emt



NEW APPLICATION

124/38

PATENT OFFICE DATE STAMP

**COPY TO BE STAMPED BY PATENT OFFICE
AND RETURNED BY MESSENGER**